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P5

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
097782,539	02/13/01	BROTTO	D TN-1379A

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EXAMINER

TIBBITS, P

ART UNIT	PAPER NUMBER
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2838

DATE MAILED:

08/08/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No. 09/782,539	Applicant(s) Brotto et al.
Examiner Pia Tibbits	Art Unit 2838

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on Jul 13, 2001

2a) This action is FINAL. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle* 1035 C.D. 11; 453 O.G. 213.

Disposition of Claims

4) Claim(s) 25-32 is/are pending in the applica

4a) Of the above, claim(s) _____ is/are withdrawn from considera

5) Claim(s) _____ is/are allowed.

6) Claim(s) 25-32 is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claims _____ are subject to restriction and/or election requirem

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on _____ is/are objected to by the Examiner.

11) The proposed drawing correction filed on _____ is: a) approved b)disapproved.

12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

13) Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

a) All b) Some* c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

15) Notice of References Cited (PTO-892)

18) Interview Summary (PTO-413) Paper No(s). _____

16) Notice of Draftsperson's Patent Drawing Review (PTO-948)

19) Notice of Informal Patent Application (PTO-152)

17) Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____

20) Other: _____

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DETAILED ACTION

This Office action is in answer to the amendment filed July 13, 2001.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 25-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bauer [4636961].

Bauer discloses a control circuit for a **power tool** which includes a data input device for entering information concerning the kind of material to be treated and other information relevant to the operation of the tool. The selected binary coded address word is applied to addressing inputs of a read only memory storing control words for a controlling device for a motor of the tool. Part of the bits of a control word outputted from the **ROM** are applied to a display device which displays the desired or actual rotary speeds of the tool and/or other data selected by the input device. The input device generates binary output signals which are employed as addresses for the storage device which is preferably in the form of a **ROM or PROM** and the other part of the output signals from the storage device which are fed to the control device of the motor of the tool, corresponds to the selected input data. As a result, the optimum rotary speed of the electric motor of the tool is adjusted. At the same time, the first mentioned part of the output signal from the storage device serves for displaying the selected material, rotary speed and the like. Bauer specifically disclosed that the correlation of rotary speed value and of the control signal for the limiting of the rotary speed is programmed in the **ROM** or a programmable read only memory (**PROM**), and that **PROM** has the advantage that it can be programmed by the user and easily reprogrammed.

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Official Notice is taken with regard to claim 28, the limitation regarding the stored information is downloadable into a computer since it is well known in the art to use a computer to optimize a process by using information stored in memory for feedback.

With regard to claim 30: the stored information comprising length of use type data, absent any criticality, is considered to be nothing more than a choice of engineering skill, because neither non-obvious nor unexpected results, i.e., results which are different in kind and not in degree from the results of the prior art, will be obtained as long as an operator will be able to optimize the parameters of the tool.

3. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

Response to Arguments

4. Applicant's arguments filed on July 13, 2001 have been fully considered but they are not persuasive. In response to Applicant's argument stated on page 2, lines 10-14 that the Bauer reference fails to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., that storing the use profile information in a memory for later analysis) are not recited in the rejected claims. **Applicant does not claim a temporal sequence for storing the use profile information.** Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ 2d 1057 (Fed. Cir. 1993).

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Conclusion

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The prior art cited in PTO-892 and not mentioned above disclose related apparatus.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Pia Tibbits whose telephone number is (703) 308-7305. If unavailable, contact the Supervisory Patent Examiner Peter Wong whose telephone number is (703) 305-3477.

8. Any inquiry of a general nature or relating to the status of this application should be directed to the Technology Center receptionist whose telephone number is (703) 308-0956.

Papers related to Technology Center 2800 applications **only** may be submitted to Technology Center 2800 by facsimile transmission. Any transmission not to be considered an official response must be clearly marked "DRAFT". The faxing of such papers must conform with the notice published in the Official

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Gazette, 1096 OG 30 (November 15, 1989). The Technology Center Fax Center number is (703) 308-7722
or (703) 308-7724.

PFT

August 7, 2001



Peter S. Wong
Supervisory Patent Examiner
Technology Center 2800